

Remarks

I. Support for Amendments

Support for the foregoing amendments to the claims may be found throughout the specification as originally filed, either inherently or explicitly. Specifically, the amendments sought to be made to claims 3 and 17 have been suggested by the Examiner in the present Office Action (*see* Paper No. 4 at page 3, section 5, lines 2-3), and in any event are supported in the specification, *inter alia* at pages 4 and 13. Hence, the foregoing amendments to the claims do not add new matter, and their entry into the present application is respectfully requested.

II. Status of the Claims

By the foregoing amendments, claims 7-14 and 21-28 have been cancelled, and claims 3 and 17 have been amended. These amendments do not add new matter. Upon entry of the foregoing amendments, claims 1-6 and 15-20 are pending in the application, with claim 1 being the sole independent claim.

III. Summary of the Office Action

In the Office Action dated June 4, 2001, the Examiner has made one objection to the specification, and two rejections of the claims. Applicants respectfully offer the following remarks to overcome or traverse each element of this rejection in the Office Action.

IV. *The Objection to the Specification*

In the Office Action at page 3, section 2, the Examiner has objected to the drawings for reasons specified by the Draftsperson on the Form PTO-948 attached to Paper No. 4. Applicants are in the process of preparing formal drawings corresponding to the informal drawings filed with the present application, which it is believed will accommodate the objections of the Draftsperson as set forth on the Form PTO-948. Accordingly, it is respectfully requested that the objection to the specification be held in abeyance until the formal drawings are filed.

V. *The Rejection Under 35 U.S.C. § 112, Second Paragraph, Is Traversed*

In the Office Action at page 3, sections 4-5, the Examiner has rejected claims 3 and 7 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Specifically, the Examiner contends that there is insufficient antecedent basis for the recitation of "the molecule" in line 1 of each of these claims, and has suggested amending these claims to recite "the DNA molecule." Applicants thank the Examiner for this helpful suggestion, and note that claims 3 and 7 have now been amended as suggested by the Examiner. Hence, this rejection has been fully accommodated; reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, second paragraph, are therefore respectfully requested.

VI. *The Rejection Under 35 U.S.C. § 102(e) Over the '365 Patent Is Traversed*

In the Office Action at pages 3-4, section 6, the Examiner has rejected claims 1-6 and 15-21 under 35 U.S.C. § 102(e) as being anticipated by Tabor *et al.*, U.S. Patent No.

5,614,365 (Doc. "A" cited on the Form PTO-892 attached to Paper No. 4; hereinafter "the '365 patent"). Applicants respectfully traverse this rejection.

Concurrently herewith, Applicants have filed a Declaration Under 37 C.F.R. § 1.131(a) by Dr. Deb K. Chatterjee ("the Chatterjee Declaration," filed with supporting exhibits), and Declarations in support of the Chatterjee Declaration by Elizabeth Flynn, Gary Gerard, Adam Goldstein, A. John Hughes, Jr., Roger Lasken, Flora Lichaa, Mary Longo, Brian Schmidt, Harini Shandilya and Kalavathy Sitaraman. Together, these declarations establish a date of invention for the presently claimed invention that is prior to the earliest possible effective filing date of the '365 patent (*i.e.*, prior to October 17, 1994). Therefore, Applicants respectfully assert that the '365 patent does not qualify as a "patent granted on an application for patent by another filed in the United States before the invention" by the present Applicants. Hence, Applicants respectfully assert that the '365 patent is not available as prior art against the presently claimed invention, and any rejection under 35 U.S.C. § 102 based on the disclosure of the '365 patent is in error.

In view of the foregoing remarks, reconsideration and withdrawal of the rejection of claims 1-6 and 15-21 under 35 U.S.C. § 102(e) over the '365 patent are respectfully requested.

VII. Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all of the outstanding rejections.

It is believed that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt entry and favorable consideration of the foregoing amendments and remarks, and allowance of all pending claims, are earnestly solicited.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

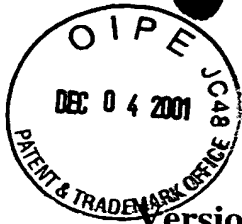


Brian J. Del Buono
Attorney for Applicants
Registration No. 42,473

Date: Dec. 4, 2001

1100 New York Avenue, N.W.
Suite 600
Washington, D.C. 20005
(202) 371-2600

P:\USERS\BRIAND\0942\3600003\PI04-45.wpd



RECEIVED

DEC 07 2001

TECH 1000/2900 CHATTERJEE *et al.* Appl. No. 09/558,421

Version with markings to show changes made

In the Claims:

Claims 7-14 and 21-28 are cancelled.

The remaining claims are sought to be amended as follows:

3. (Once amended) The DNA molecule of claim 2, wherein said coding sequence is heterologous to said promoter.

17. (Once amended) The DNA molecule of claim 16, wherein said coding sequence is heterologous to the promoter.